

REMARKS

In the November 18, 2003 Office Action, the Examiner noted that claims 1-19 were pending in the application; rejected claims 11-13 under 35 U.S.C. § 101; and rejected claims 1-19 under 35 U.S.C. § 103(a). In rejecting the claims, U.S. Patents 6,332,126 to Peirce et al. and 5,918,215 to Yoshioka et al. (References A and B, respectively) were cited. Claims 1-19 remain in the case. The Examiner's rejections are traversed below.

Rejections under 35 U.S.C. § 101

On page 2 of the Office Action, claims 11-13 were rejected under 35 U.S.C. § 101 because the claimed method allegedly does not recite a limitation in the technological arts. In making this rejection, language was quoted from claim 11 prior to the changes in the Amendment filed by Certificate of Mail on September 2, 2003 and received by the U.S. Patent and Trademark Office on September 3, 2003. It was then asserted that the quoted language recites "abstract ideas which can be performed mentally without interaction of a physical structure" (Office Action, page 2, lines 14-15) and that "'displaying information about the service on the screen' may be understood as merely presenting a sheet of paper with hand-written signs on it" (Office Action, page 2, lines 15-17).

First, it is noted that the limitation "in a membership qualification system" that was recited at lines 2-3 of claim 11 in the September 2, 2003 Office Action and on line of claim 12 from which claim 11 now depends, identifies where the membership conditions are stored. The paraphrase of claim 11 on page 2 of the Office Action did not include this limitation. It is submitted that this phrase clearly recites interaction with a physical structure, so that the claimed invention utilizes "technology in a non-trivial manner".

Furthermore, it is submitted that the statement quoted above from page 2, lines 15-17 of the Office Action is clearly inaccurate, as is apparent from the words quoted from claim 11, because "on the screen" is not equivalent to "a sheet of paper". It is submitted that proper interpretation of the limitation as now recited at the end of claim 1, "displaying information about the eligible service of which the user can become a member to the user on the screen" requires the use of a device that has the ability to display information a screen, not merely a sheet of paper.

Rejections under 35 U.S.C. § 103

On pages 3-6 of the Office Action, claims 1-19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peirce et al. in view of Yoshioka et al. To further clarify the differences between the present invention and the cited prior art, claims 4, 9, 12, 15 and 18 have been amended to recite “membership qualification tables” as described at, e.g., page 34, line 23 to page 35, line 2 and page 42, line 3 to page 43, line 25. For example, claim 9 recites that each of the membership qualification tables includes “qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have membership qualification for the corresponding service” (claim 9, lines 6-8). Thus, qualification criterion information can be provided by a service provider to indicate that a subscription request to a new service may be accepted without performing a membership qualification condition assessment if the request is from an existing member subscribing to a different service which the service provider considers sufficient information to qualify for the service being requested.

As described in the September 2, 2003 Amendment, Peirce et al. only discloses that “merchants must satisfy the Merchant Qualification Criterion” (column 5, lines 47-48), while cardholders are targeted based on characteristics defined by merchants or “Dealmakers” (e.g., column 6, line 5) and whether cardholders receive offers generated by merchants or dealmakers is controlled by issuers of credit cards “by providing merchant exclusion and prioritized parameters for each Card Group” (column 9, lines 17-19). As illustrated in Figs. 1 and 1.5, determining whether cardholders qualify requires detailed examination of purchase history records that are generated as described at column 9, line 48 to column 10, line 42. No suggestion has been found in Peirce et al. with or without modification by Yoshioka et al. to simplify the process of determining qualification for “a second service in the membership qualification service based on the identification information of the first service included in the qualification criterion information for qualifying membership of the second service” (claim 9, lines 9-11).

In the last full paragraph on page 3 of the Office Action, it was asserted that it would have been obvious to one of ordinary skill in the art “to modify Peirce et al. and Yoshioka et al. to include ... a request to present an available membership service” (Office Action, page 4, lines 15-17). However, the reason why this would be obvious was not clear from the words on the following lines (17-20). Nothing has been cited in the prior art providing any suggestion to modify Peirce et al. combined with Yoshioka et al. to use membership qualification tables containing the information recited in claims 4, 9, 12, 15 and 18. If the rejection of the claims is

maintained, the Examiner is respectfully requested to cite evidence of the obviousness of the modification, in accordance with MPEP §2144.03.

Claims 1-3 depend from claim 4, claim 8 depends from claim 9, claim 11 depends from claim 12, claim 14 depends from claim 15, and claim 17 depends from claim 18. Therefore, it is submitted that claims 1-4, 8, 9, 11, 12, 14, 15, 17 and 18 patentably distinguish over Peirce et al. in view of Yoshioka et al. for the reasons discussed above. Claims 6, 10, 13, 16 and 19 have been amended to recite "service tables including a membership condition of a corresponding service of the existing services" (claim 10, lines 4-5), or a similar limitation. Therefore, it is submitted that claims 6, 10, 13, 16 and 19, as well as claim 7 which depends from claim 6, patentably distinguish over Peirce et al. in view of Yoshioka et al. for the reasons discussed above.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination do not teach or suggest the features of the present claimed invention, all of which recite patentable subject matter. Thus, it is submitted that claims 1-19 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 18, 2004
By: Michelle Bryant
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